UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,657	02/11/2002	Dane R. Jackson	460.1754USX	9082

7590 03/21/2003

CHARLES N.J. RUGGIERO, ESQ.
OHLANDT, GREELEY, RUGGIERO & PERLE, L.L.P.
ONE LANDMARK SQUARE, 10th FLOOR
STAMFORD, CT 06901-2682

EXAMINER
RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
3761	

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

Office Action Summary	Application No. 10/073,657	Applicant(s) JACKSON ET AL.	
	Examiner Dennis Ruhl	Art Unit 3761	

-- Th MAILING DATE of this communication app ars on the cover sh t with th correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 February 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,4,6,7,13,16-18,21 and 23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,4,6,7,13,16-18,21 and 23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

With respect to the IDS of 5/18/02, the two references from Switzerland (135077 and 186674) have not been considered because they were not considered in the parent case and to have them considered copies were required, none of which have been provided. The PTO 892 that applicant provided as an IDS is not a proper IDS, but the examiner has simply placed the reference to Voss on the 1449 and it has been considered.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 16,17,23, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 16,17,23, these claims depend to canceled claims and because of this the scope of these claims is not known. The examiner has applied prior art to these claims (as best as possible) as if they depended to claim 1. There is no antecedent basis for "said paper-based layer" and "said nonwoven material".

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,3,4,13,21,23, are rejected under 35 U.S.C. 102(b) as being anticipated by Voss (3575169). Applicant should take notice that Voss has been used in two manners. This is because there are multiple embodiments disclosed by Voss.

1st Rejection

With respect to claims 1,4, Voss discloses an applicator that has a gripping structure. The outer barrel is 14 and the 3-d tape is disclosed in column 4, lines 11-18 or in column 4, lines 38-41 and lines 44,45. The gripping structure is elements 40 or the abrasive particles. The adhesive 2nd surface is disclosed in column 4, lines 11-18 or column 4, lines 44,45.

2nd Rejection

With respect to claims 1,4,21, Voss discloses an applicator that has a gripping structure. The outer barrel is 14 and the 3-d tape is 44,50, or 60. The gripping structure is 46,56 (wavy surface). The adhesive 2nd surface is disclosed in column 2, lines 22,23. the 2nd surface is heated to an elevated temperature as claimed.

With respect to claim 3, the wavy surface extends inwardly as claimed because of the wavy surface itself.

With respect to claims 13,23, Voss does not specifically disclose that the tape is formed of polypropylene (or those of claim 23) even though Voss does disclose that the tape is formed from plastic materials. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the plastic tape of Voss from polypropylene (or those of claim 23) because polypropylene (and those of claim 23) is a widely used plastic material that is used to form tampon applicators (and related components). The choice of what specific plastic material is used to make the tape from will not materially affect how the tape operates or functions so based on the fact

that Voss discloses that the tape can be plastic, reciting that the tape is made from polypropylene is not sufficient to patentably distinguish over Voss.

With respect to claim 21, see column 2, lines 22,23.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voss (3575169) in view of Voss (3347234). Voss '169 discloses the invention substantially as claimed

With respect to claims 16,18, Voss '169 does not disclose that the applicator barrel is a paper based or plastic. Voss '234 discloses a tampon applicator that has a gripping structure. Voss '234 discloses in column 5, lines 62 to end of column 5, that the applicator barrel can be made from paper based materials or plastic materials (as

are extremely well known in the art). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the applicator barrel from paper or plastic due to their ease of manufacturing and their easy availability. Paper and plastic based applicators are extremely well known and old in the art and the use of paper or plastic for the barrel material is very obvious to one of ordinary skill in the art.

With respect to claim 17, Voss '234 discloses a plastic coating for the paper based blank.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1,3,4,6,7,13,16-18,21,23, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,2,3,8,11-13,16-18, of U.S. Patent No. 6416488. Although the conflicting claims are

not identical, they are not patentably distinct from each other because the instant pending claims fail to recite: that the tape is made from synthetic material, that there are a plurality of gripping structures, and that the gripping structures are in rows/columns. This is a broadening out of the claims (In re Goodman 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993). Another reason for a terminal disclaimer is to maintain common ownership of claims of overlapping scope.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 703-308-1957. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

DR
March 20, 2003

DENNIS RUHL
PRIMARY EXAMINER